

### **REMARKS**

The Applicants thank the Examiner for the thorough consideration given the present application. Claims 1-24 are pending. Claim 5 is amended and claims 19-24 are added. Claims 1, 7, and 13 are independent. The Examiner is respectfully requested to reconsider the rejections in view of the amendments and remarks set forth herein.

### **Allowable Subject Matter**

The Examiner states that claims 5, 6, 11, 12, 17, and 18 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The Applicants appreciate the Examiner's early indication of allowable subject matter. As indicated below, rather than rewriting any of objected to claims 5, 6, 11, 12, 17, and 18 in independent form at this time, independent claims 1, 7, and 13 are believed to be in condition for allowance as currently written.

### **Drawings**

It is gratefully appreciated that the Examiner has accepted the drawings.

### **Claim for Priority**

It is gratefully appreciated that the Examiner has recognized the Applicants' claim for foreign priority.

**Acknowledgement of Information Disclosure Statement**

It is gratefully appreciated that the Examiner has acknowledged the Information Disclosure Statement filed on April 19, 2001.

**Rejection Under 35 U.S.C. § 112, second paragraph**

Claim 5 stands rejected under 35 U.S.C. § 112, second paragraph because of an informality. This rejection is respectfully traversed.

In order to overcome this rejection, the Applicants have amended claim 5 to address the issue pointed out by the Examiner. The Applicants respectfully submit that claim 5, as amended, particularly point out and distinctly claim the subject matter which the Applicants regard as the invention. Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

**Rejection Under 35 U.S.C. §103(a)**

Claims 1-4, 7-10, and 13-16 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Shaffer et al. (U.S. 6,434,579) in view of Sarbadhikari et al. (U.S. 5,477,264). These rejections are respectfully traversed.

**Arguments Regarding Independent Claims 1, 7, and 13**

As note above, the Applicants respectfully submit that each of independent claims 1, 7, and 13 sets forth a novel combination of features not taught or suggested by the references cited by the Examiner, including Shaffer et al. and Sarbadhikari et al.

Each of independent claims 1, 7, and 13 as currently written sets forth a combination of features, including *inter alia*

reading the image data sets and the accompanying information added thereto from the recording medium; and

generating composite image data representing the composite image based on the accompanying information by inserting the respective images represented by the image data sets in image insertion areas of a template having the image insertion areas corresponding to the accompanying information.

The Examiner asserts that Sarbadhikari et al. disclose that accompanying information is used in the creation of the composite image. However, "Christmas Album", which the Examiner regards as the accompanying information, is labeled on a storage device, and is not added to the image data sets. Also, according to Sarbadhikari et al., the information of "Christmas Album" is merely used for selecting the seasonal templates without input from the user, and is not used for inserting the images represented by the image data sets in image insertion areas of the template. Further, although Sarbadhikari et al. disclose that multiple images may be inserted into a single template to create the composite image, this document does not disclose using the accompanying information when inserting multiple images into the single template. Therefore, it would not have been obvious to one of ordinary skill in the art to modify the album generation method of Shaffer et al. to include the automatic image insertion process of Sarbadhikari et al. to arrive at the characteristic feature of the present invention defined in independent claims 1, 7 and 13. Sarbadhikari et al. do not disclose using accompanying information to create the composite image as presently claimed.

At least for the reasons described above, the Applicants respectfully submit that the combination of features set forth in each of independent claims 1, 7, and 13 is not disclosed or made obvious by the prior art of record, including Shaffer et al. and Sarbadhikari et al. Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

Therefore, independent claims 1, 7, and 13 are in condition for allowance.

**Dependent Claims**

As for dependent claims 3, 4, 9, 10, 15, and 16, the Examiner asserts that Shaffer discloses that the accompanying information can be inserted into the template. However, the Applicants respectfully submit that this is not the case. Shaffer et al. merely disclose that annotation text input by the user is inserted to the template. This is not the same as accompanying information added to the image data, as set forth in the present invention.

Thus, Shaffer et al. fail to suggest the subject matter of claims 3, 4, 9, 10, 15, and 16.

In addition, the Examiner will note that dependent claims 19-21 have been added to set forth additional novel features of the present invention.

Each of dependent claims 2-6, 8-12, and 14-24 is in condition for allowance due to its dependency from an allowable independent claim, as well as for the additional novel limitations set forth therein.

Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. §103(a) are respectfully requested.

All claims of the present application are in condition for allowance.

**CONCLUSION**

Since the remaining patents cited by the Examiner have not been utilized to reject claims, but merely to show the state of the art, no comment need be made with respect thereto.

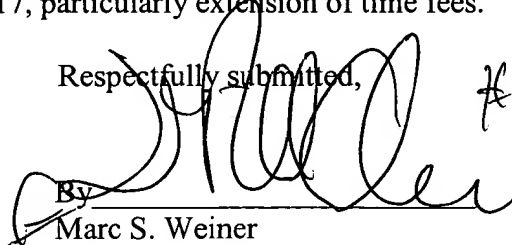
All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. It is believed that a full and complete response has been made to the outstanding Office Action, and that the present application is in condition for allowance.

Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), Applicant(s) respectfully petition(s) for a two (2) month extension of time for filing a reply in connection with the present application, and the required fee of \$450.00 is attached hereto.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, he is invited to telephone Carl T. Thomsen (Reg. No. 50,786) at (703) 205-8000.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17, particularly extension of time fees.

Respectfully submitted,

 #40,439

Marc S. Weiner  
Registration No.: 32,181  
BIRCH, STEWART, KOLASCH & BIRCH, LLP  
8110 Gatehouse Road  
Suite 100 East  
P.O. Box 747  
Falls Church, Virginia 22040-0747  
(703) 205-8000  
Attorney for Applicant

MSW/CTT/jmb